

REMARKS

Claims 1, 5-9, 11-14, 18, 20-27 and 31-41 are pending in the present application. Claims 2-4, 10, 15-17, 19, and 28-30 are cancelled.

Rejections under 35 U.S.C. §102 and 103

a) *Corey et al.* - Claims 1, 5, 9, 12-13, 18, 24-27, 35 and 37-40 are rejected under 35 U.S.C. §102(b) as being anticipated by *Corey et al.*

In the response of June 21, 2004, Applicants distinguished the invention from the teachings of *Corey et al.* based on the fact that in *Corey et al.* the nickel carbonyl is acting as both a CO source and a catalyst. In response to those arguments, the Examiner bases support for maintaining the rejection on the recitation of a "metal catalyst" in the present claims.

Specifically, the Examiner relies on the disclosure in the specification at page 24, which defines the metal catalyst as "a metal with a ligand." The Examiner interprets this definition as encompassing the nickel carbonyl of *Corey et al.* Thus, the Examiner takes the position that there is an overlap with the present invention in the definitions of the metal carbonyl of formula I and the metal catalyst. The Examiner further asserts that the nickel carbonyl of *Corey et al.*, by allegedly meeting the

definition in the specification for a metal catalyst and falling within formula I for the metal carbonyl would meet both features recited in claim 1 of a non-catalyzing solid CO releasing compound of formula I and a metal catalyst.

However the Examiner's position is both legally and scientifically baseless and flawed. For the Examiner's position to be supported, the same compound in the reaction must be at the same time both catalyzing and non-catalyzing. This is scientifically absurd. In addition, the Examiner ignores the explicitly recited feature in the claims that the metal carbonyl of formula I is non-catalyzing. While the Examiner must give the claims the broadest reasonable interpretation, the Examiner's interpretation of the claims is unreasonable because explicitly recited features must be ignored under the Examiner's interpretation. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Corey et al. fails to disclose either explicitly or inherently a non-catalyzing metal carbonyl of formula I used in combination with separate metal catalyst. As such, the present invention is not anticipated by the reference and the rejection must be withdrawn.

Claim 41 has been further rejected as being anticipated by Corey et al. Applicants traverse this rejection and withdrawal thereof is respectfully requested. Claim 41 explicitly recites that the kit contains two different components: a non-catalysing solid CO releasing compound which is a carbonyl of the general formula I, $M_x(CO)_y$; and a metal catalyst. Corey et al. discloses only a single component, which is both the CO releasing compound and the catalyst. As such, Corey et al. fails to disclose each recited feature of claim 41 and withdrawal of the rejection is respectfully requested.

b) Zoeller et al. and Zoeller et al. combined with Lidström et al. - Claims 1, 5-9, 11, 13-14, 18-20, 20-27, 31-35 and 37-40 are rejected under 35 U.S.C. §102(b) as being anticipated by Zoeller et al. Claims 1, 5-9, 11-14, 18, 20-29 and 31-36 further are rejected under 35 U.S.C. §103 as being obvious over Zoeller et al. combined with Lidström et al. Applicants traverse these rejections and withdrawal thereof is respectfully requested.

As with Corey et al., the Examiner asserts that the metal carbonyl of Zoeller et al. can be both the non-catalyzing metal carbonyl of claim 1 and the metal catalyst of claim 1. For the reasons discussed above regarding Corey et al., this reasoning is

flawed and as a result the rejections are baseless. As discussed above, the present claims contain the explicitly recited separate features of a metal carbonyl of formula I that is non-catalyzing and a metal catalyst. As noted previously, in Zoeller et al. the molybdenum carbonyl is not acting as a CO source. In addition, the Examiner's interpretation of the reference that the metal carbonyl of Zoeller et al. can be both the non-catalyzing metal carbonyl of claim 1 and the metal catalyst of claim 1 is scientifically incorrect, because that compound would need to be both catalyzing and non-catalyzing at the same time, which is impossible. As such, the present invention is neither anticipated by nor obvious over Zoeller et al. or Zoeller et al. combined with Lidström et al. Withdrawal of the rejection is, therefore, respectfully requested.

Claim 41 has been further rejected as being anticipated by Zoeller et al. or obvious over Zoeller et al. combined with Lidström et al. (While the italicized portion of the rejection of Item 22 references Brunet et al., Applicants believe the reference to Brunet et al. to be in error, with the proper citation being to Zoeller et al., as discussed in the body of the rejection.) Applicants traverse these rejections and withdrawal thereof is respectfully requested.

As discussed above, claim 41 explicitly recites that the kit contains two different components: a non-catalysing solid CO releasing compound which is a carbonyl of the general formula I, $M_x(CO)_y$; and a metal catalyst. Zoeller et al. discloses only a single component, which is both the CO releasing compound and the catalyst. As such, Zoeller et al. fails to disclose each recited feature of claim 41. Lidström et al. similarly fails to disclose the separate a non-catalysing solid CO releasing compound which is a carbonyl of the general formula I, $M_x(CO)_y$ and a metal catalyst. As such, the invention of claim 41 cannot be achieved by combining the teachings of Zoeller et al. and Lidström et al. The invention is therefore not obvious over the references and withdrawal of the rejection is therefore respectfully requested.

Rejections under 35 U.S.C. §112, 2nd paragraph

In Item 17 of the Office Action, the Examiner rejects newly added claim 37 as being indefinite with the assertion that the method of claim 1 would only produce a single compound because the method of claim 1 is a "one-pot" reaction. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

The Examiner appears to misunderstand the meaning of "one-pot reaction". "One-pot" reaction is a commonly used term in chemistry

that means a reaction that is carried out in a single reaction vessel and with the advantage of putting all of the reactants into "one pot" without having to do separation steps for intermediates. Withdrawal of the rejection is respectfully requested.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

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required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s)